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Image Rights and Passing Off: Should Reputation be Enough for Celebrities to Succeed in English Courts?

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This article

- While there are no image rights in English law, celebrities typically rely on the tort of passing off to restrain the unauthorised use of their images. However, in 2015, the UK Supreme Court in *Starbucks (HK) v. Sky* ruled that mere reputation is not enough to succeed in an action for passing off and that claimants must show goodwill in the form of customers within the country.
- This article critically examines the potential impact that the decision in *Starbucks (HK)* could have on the ability of celebrities to rely on the tort of passing off in English courts. It highlights some of the criticisms against this decision including suggestions that a distinction should be drawn between commercial traders on the one hand and celebrities on the other hand, with regard to the question of establishing goodwill.
- This article contends that both transnational businesses and global celebrities should be required to show goodwill. This will help to maintain the balance between the public interest in free competition and the protection of the trader/celebrity against passing off.

Introduction

The courts in England and Wales have consistently maintained that there is no right to control the use of one's image under English law.¹ Nevertheless, where the facts satisfy the requirements of the classic trinity of goodwill, misrepresentation, and damage to goodwill, celebrities can rely on the tort of passing off to prevent the unauthorised use of their names or images.² This has not always been an easy option and it has been particularly difficult for some celebrities to satisfy some of the elements of the classic trinity, especially the requirement of

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¹ In other words, according to the courts, there is no image right in English law. See, *Douglas v. Hello!* [2007] UKHL 21 at para 124 (where Lord Hoffman noted that, 'There is in my opinion no question of creating an "image right" or any other unorthodox form of intellectual property.'). See also, *Fenty v. Arcadia* [2015] EWCA Civ 3 at para 29 (where Kitchen LJ stated that 'There is in English law no "image right" or "character right" which allows a celebrity to control the use of his or her name or image.'). This reluctance to recognise any sui generis rights with regard to controlling the use of names or images has its roots in some nineteenth century cases such as *Clark v. Freeman* (1848) 50 ER 759; 11 Beav. 112 and *Dockrell v. Dougall* (1899) 15 TLR 333.

² See, *Spalding (AG) & Bros v AW Gamage Ltd* (1915) 32 RPC 273; *Erven Warnink BV v. Townend (Advocaat)* [1979] AC 731 HL; *Reckitt & Colman Products Ltd v. Borden Inc (Jif Lemon)* [1990] 1 WLR 481 HL.

misrepresentation.³ However, some other celebrities have been able to successfully rely on the tort of passing off to restrain defendants from using their images without authorisation.⁴

Given the importance of the tort of passing off to celebrities under English law, it is therefore crucial to critically examine the potential impact that the judgement of the UK Supreme Court in *Starbucks (HK) Ltd v. British Sky Broadcasting Group Plc* (hereinafter, *Starbucks (HK)*) could have on the ability of celebrities to rely on the tort of passing off in the courts of England and Wales.⁵ In this case, the Supreme Court ruled that mere reputation is not enough to succeed in a passing off action and that claimants must show goodwill in the form of customers within the jurisdiction.⁶ This decision (which applies to both commercial traders and celebrities) is all the more important in relation to celebrities because of the transnational nature of the celebrity phenomenon as a result of the internet.⁷

One important implication of the decision in *Starbucks (HK)* for celebrities with a global reputation is that they will either have to take steps to exploit their names or images in the country through endorsements in order to establish the requisite goodwill or take steps to obtain trade mark protection for their names or images.⁸ Crucially, the *Starbucks (HK)* decision also highlights one of the key differences between the right of publicity in the US and the tort of passing off in English law. While a full discussion of the right of publicity is beyond the scope of this article, it is worth noting that there is no requirement to establish goodwill in an action based on the right of publicity and all that is required is the appropriation of the commercial value of a person's name or likeness without consent.⁹ The decision in *Starbucks (HK)* equally raises the question regarding whether it is now time for English courts to recognise a new tort of publicity rights in order to provide better protection for celebrities under English law.¹⁰

³ See generally, *McCulloch v. May* [1947] 2 All ER 845 (no common field of activity between the parties); *Harrison and Starkey v. Polydor* [1977] FSR 1 (no misrepresentation); *Lyngstad v. Anabas* [1977] FSR 62 (failure to establish goodwill and misrepresentation); *Merchandising Corporation v. Harpbond Ltd* [1983] FSR 32 (no misrepresentation); *Halliwel v. Panini* [1997] Lexis Citation 1087 (unreported decision of the Chancery Division per Lightman J, 6 June 1997; no misrepresentation).

⁴ *Hines v. Winnick* [1947] Ch. 708; *Marengo v. Daily Sketch and Sunday Graphic* (1948) 65 RPC 242; *Clark v. Associated Newspapers* [1998] RPC 261; *Irvine v. Talksport Ltd* [2002] EWHC 367; [2003] EWCA Civ. 423; *Fenty v. Arcadia* [2015] EWCA Civ. 3

⁵ [2015] UKSC 31.

⁶ *Ibid* para 47.

⁷ As David Tan rightly points out, 'Although celebrities in the twentieth century generally relied on the mass media – print and broadcast – to propagate their notoriety, individuals today have access to a much wider spectrum of media outlets. In the twenty-first century, the escalating growth in the range of media outlets and the vastly increased speed of circulation of information can combine to create the phenomenon of a vortex effect. In the midst of a vortextual moment, the public persona of a celebrity can be born almost instantaneously, when the newspapers, television, radio, tabloids, columnists, Internet chat rooms, social media postings and blogs are all drawn into the same topic.' See, D Tan, *The Commercial Appropriation of Fame: A Cultural Analysis of the Right of Publicity and Passing Off* (CUP, 2017) 23.

⁸ For instance, in 2011, Lady Gaga successfully relied on trade mark law to protect her name in an English court. See, *Ate My Heart Inc. v. Mind Candy* [2011] EWHC 2741.

⁹ See, Section 46 of the Restatement (Third) of Unfair Competition (1995); Tan (n 7) 39. For a critical discussion of the historical development of the right of publicity see, J Rothman, *The Right of Publicity: Privacy Reimagined for a Public World* (Harvard University Press, 2018).

¹⁰ In the context of privacy law, with the help of the Human Rights Act, English courts have been able to recognise a new tort of misuse of private information which was derived from the tort of breach of confidence. See, *Campbell v. MGN Ltd.* [2004] UKHL 22 at para 14. Interestingly in *Irvine*, Laddie J was willing to explore the possibility of using the Human Rights Act to protect the claimant if the tort of passing off had not developed sufficiently to protect against false endorsements. However, in that case, Laddie J came to the conclusion that the law of passing

The approach of the Supreme Court in the *Starbucks (HK)* case has however been criticised. For instance, it has been contended that the presence of customers within a jurisdiction should not be determinative with regard to finding goodwill and, in any case, it should not pre-empt the full analysis of the tort as a whole.¹¹ Furthermore, the distinction between goodwill and mere reputation has equally been questioned.¹² It has even been suggested that a distinction should be drawn between commercial traders on the one hand and celebrities on the other hand with regard to the question of establishing goodwill.¹³ Are these criticisms and suggestions correct? Is it time to ditch the requirement of goodwill for celebrities with a global reputation and should it be enough for such celebrities to be well-known in order to succeed in a passing off action?

This paper contends that the decision in *Starbucks (HK)* reflects a strict adherence to the elements of the classic trinity that constitute the tort of passing off.¹⁴ An oft cited definition of goodwill is that provided by Lord Macnaghten in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* to the effect that '[i]t is the benefit and advantage of the good name, reputation, and connection of a business' and 'the attractive force which brings in custom.'¹⁵ In his definition of goodwill, Lord Macnaghten acknowledged that the composition of goodwill 'differs in its composition in different trades and in different businesses in the same trade.'¹⁶ He, however, stressed that there is an attribute that is common to all cases of goodwill i.e. the attribute of locality.¹⁷ In other words, whether one is dealing with commercial traders or celebrities, there is still a need to localise goodwill. In essence, the goodwill must be attached to a business within the jurisdiction.

Furthermore, it will also be contended below that the reasons adduced by the Supreme Court in support of its decision in *Starbucks (HK)* apply with equal force to both commercial traders and celebrities. Crucially, one of the reasons adduced by the Supreme Court in this regard is the need to achieve a balance between facilitating free competition and protecting against unfair competition.¹⁸ This reason equally provides a justification for why celebrities should be required to have local goodwill before they can rely on passing off to prevent unauthorised uses of their images in English courts. More importantly, unless one is in favour of the recognition

off secured to Irvine the protection that he sought. See, *Irvine v. Talksport Ltd* [2002] EWHC 367 at para 77. There is thus a possibility for English courts to recognise a new tort of publicity rights that is derived from (but separate from) the tort of passing off.

¹¹ See, C Ng, 'Goodwill without Borders' (2018) 134 LQR 285, 293.

¹² Ibid 286, 305.

¹³ See Tan (n 7) 208 (noting that, '[t]he celebrity individual often does not manufacture or trade in a particular product. The actionable goodwill of celebrities lie in their commercial potential or associative value at the time when passing off is alleged'). Tan further contends that in cases involving celebrities, '[t]he goodwill inquiry should not be focused on whether there was prior commercial exploitation of the celebrity persona in terms of endorsements or merchandising, but rather on whether the plaintiff was well-known in the jurisdiction based on promotional or publicity campaigns, television appearances ... as well as Internet presence.' Ibid 214.

¹⁴ Carty stresses the importance of strictly adhering to the elements of the classic trinity and she contends that 'it is dangerous to substitute analogous concepts such as reputation for goodwill' and that 'goodwill is about customer connection, not simply reputation per se or its equivalent.' She equally clarifies that, according to case law, 'customer connection is not simply market recognition; an attractive name; or brand "aura"'. See, H Carty, 'Passing Off: Frameworks of Liability Debated' (2012) 2 IPQ 106, 108.

¹⁵ [1901] AC 217, 223-224.

¹⁶ Ibid 224.

¹⁷ Ibid.

¹⁸ *Starbucks (HK)*, paras 61-62.

of a separate tort against the misappropriation of the images of celebrities,¹⁹ it is difficult to argue against the application of the decision in *Starbucks (HK)* to celebrities.

This article is divided into three parts. In the first part, there will be a critical overview of the decision of the Supreme Court in *Starbucks (HK)*. In the second part, there will be a critical discussion of the practical implications of the decision in *Starbucks (HK)* for celebrities seeking to rely on passing off to restrain the unauthorised use of their images. This will be illustrated with the example of an earlier case involving the famous musical group, ABBA.²⁰ In the third part, it will be contended that mere reputation should not be enough for celebrities to succeed in passing off actions. In other words, celebrities should be required to establish all the three elements that constitute the classic trinity of the tort of passing off, namely, goodwill, misrepresentation and damages, whenever they want to use this tort to restrain the unauthorised use of their images.

1. Goodwill or Mere Reputation: The *Starbucks (HK)* Case

In *Starbucks (HK)*, the claimants were based in Hong Kong where they provided internet protocol television services for subscribers under the moniker NOW TV. The claimants' programmes were accessible to viewers outside Hong Kong including in the UK via other means without subscription. The claimants had plans to expand its subscription service to the UK but the defendants later began to provide a similar service in the UK using the same name as the claimants. This prompted the claimants to bring an action in passing off against the defendants in the UK. This action was dismissed by the trial court on the grounds that the claimants had no goodwill in the UK as it had no subscribers within the country and this decision was upheld by both the Court of Appeal and the Supreme Court.

As noted above in the introduction, in *Starbucks (HK)*, the Supreme Court clarified that it is mandatory for a claimant to establish actual goodwill in England to succeed in a passing off action and mere reputation is not enough. According to the Supreme Court, goodwill in this regard involves the presence of clients or customers in England for the claimant's products or services.²¹ The court also noted that, 'where the claimant's business is abroad, people who are in the jurisdiction, but who are not customers of the claimant in the jurisdiction, will not do, even if they are customers of the claimant when they go abroad.'²² However, the court stated that this does not mean that it is necessary to have an office within the country and it suffices if a claimant could show that there were people in the country who, through booking with or purchasing from an entity in the country, obtained the claimant's service abroad.²³ In this regard, this entity could be an agent of the claimant and it need not be a branch of the claimant.²⁴

¹⁹ See for instance, J Davis, 'Why the United Kingdom Should Have a Law against Misappropriation' (2010) 69 CLJ 561.

²⁰ See, *Lyngstad v. Anabas* [1977] FSR 62.

²¹ *Starbucks (HK)*, para 47.

²² *Ibid*.

²³ *Ibid*, para 52.

²⁴ *Ibid*. The court however left open the question concerning a claimant with no goodwill in the country but who has launched a substantial advertising campaign within the country with the clear intention that it will soon be marketing its goods or services within the country. *Ibid* para 66.

The approach of the Supreme Court in this regard might seem odd in an interconnected world with increased cross-border trade and advanced technologies that facilitates global communication.²⁵ However, the court's decision reflects the tensions inherent in the 'glocal' nature of contemporary intellectual property rights. The term 'glocal' in this context refers to those IP rights that are subject to both global and local rules. In this regard, 'glocal' IP rights are rights that belong to entities (typically transnational corporations but also including celebrities with global reputation) and which are governed simultaneously by different national IP laws. The adoption of several multilateral treaties such as the Berne Convention, the Paris Convention, the Patent Cooperation Treaty, the Madrid Protocol, and the TRIPS Agreement has enabled the creation of these 'glocal' IP rights.²⁶ Moreover, the internet has greatly enhanced the speed with which information spreads across the globe. As a result, it has become imperative for some companies and celebrities to obtain IP protection in multiple countries even when those IP rights (such as passing off) are not specifically governed by multilateral treaties. Nevertheless, it should be noted that even with the adoption of several treaties in the field of international IP law, a foundational principle that is still acknowledged is the territoriality of IP laws.²⁷ This principle recognises the rights of states to design their national IP laws in a manner that suits their socio-economic goals and aspirations and this is reflected in the various flexibilities that are embedded in a number of IP treaties such as the TRIPS Agreement.²⁸

The tort of passing off equally reflects this principle. The proprietary element of the tort, i.e. the goodwill of a business, is subject to the territoriality principle, and in the absence of a specific treaty provision, states are free to determine the contours of the tort of passing off including the requirements for protecting goodwill within their territory. It is therefore possible for a transnational company to meet the requirements for protecting its goodwill in country A while failing to meet the requirements for protecting its goodwill in country B. Country A might choose to require the presence of customers within its country to show goodwill in order to achieve a specific policy objective while Country B might have its own policy reasons for not requiring the presence of customers in its country to show goodwill.

Thus, one of the reasons given by the Supreme Court for its decision is the territorial nature of goodwill.²⁹ According to the Supreme Court, '[t]he notion that goodwill in the context of passing off is territorial in nature is also supported by refusal of judges to accept that a court of one jurisdiction has powers to make orders in relation to the goodwill in another

²⁵ See for instance, C Ng (n 11) 285 (noting that, 'Arguably, global electronic communication and easy low-cost global travel make the case all the more compelling for not requiring a customer base within a jurisdiction before goodwill is protected there.').

²⁶ See for instance, Article 5 of the Berne Convention for the Protection of Literary and Artistic Works; Article 2 of the Paris Convention for the Protection of Industrial Property; Article 3 of the Patent Cooperation Treaty; Articles 2 and 3 of the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks; and Part II of the TRIPS Agreement.

²⁷ In this regard, see generally, Annette Kur and Thomas Dreier, *European Intellectual Property Law: Text, Cases and Materials* (Edward Elgar, 2013) 13; Justine Pila and Paul Torremans, *European Intellectual Property Law* (OUP, 2016) 30; Lydia Lundstedt, *Territoriality in Intellectual Property Law* (Stockholm University, 2016).

²⁸ See for instance, Articles 1, 7, 8, 13, 20, 30 and 31 of the TRIPS Agreement. See also the recent decision of a WTO Dispute Settlement Panel upholding the tobacco plain packaging laws of Australia. WTO, *Australia – Certain Measures Concerning Trademarks, Geographical Indications and Other Plain Packaging Requirements Applicable to Tobacco Products and Packaging*, Panel Report, WT/DS435/R, WT/DS441/R, WT/DS458/R, WT/DS467/R, (28 June 2018).

²⁹ *Starbucks (HK)*, para 55.

jurisdiction.³⁰ In this regard, the court cited with approval Wadlow's statement to the effect that the 'reason why goodwill is territorial is that it is a legal proprietary right, existing or not in any jurisdiction according to whether the laws of that jurisdiction protect its putative owner.'³¹ The court also highlighted a policy objective behind the approach adopted by English courts in this regard i.e. the need to achieve a balance between the public interest in free competition and the protection of a trader against unfair competition.³² The importance of this policy will be further discussed in the third part of this article.

2. Global Celebrities and Local Goodwill: The *ABBA* Case

While the facts of the *Starbucks (HK)* decision involved commercial traders, the implications of the decision applies to celebrities who have a global reputation as well. In this regard, it is worth noting that (unlike trade mark law) passing off does not protect a trader's sign or badge; passing off protects the goodwill that is connected to the trader's badge or sign.³³ In the case of celebrities, their sign/badge is their name or image and it is the goodwill that is attached to their name or image that is protected by the tort of passing off. Importantly, a celebrity can satisfy the requirements for showing goodwill within the country through endorsements. As Laddie J noted in *Irvine v. Talksport*:

...the court can take judicial notice of the fact that it is common for famous people to exploit their names and images by way of endorsement. They do it not only in their own field of expertise but, depending on the extent of their fame or notoriety, wider afield also. It is common knowledge that for many sportsmen, for example, income received from endorsing a variety of products and services represents a very substantial part of their total income.³⁴

Establishing goodwill is not typically a problem for most celebrities seeking to rely on the tort of passing off in English courts. For instance, in *Irvine v. Talksport* there was evidence that Mr Irvine had 'been engaged to sponsor a variety of products including, amongst others, sunglasses, men's toiletries, fashion clothing, footwear and car racing helmets.'³⁵ Also, in *Fenty v. Arcadia*, both the trial court and the Court of Appeal agreed that the scope of Rihanna's goodwill extended beyond music into the world of fashion as a style leader.³⁶ Importantly, the Court of Appeal noted that Rihanna runs very large merchandising and endorsement businesses and that between 2010 and 2011 some of the goods authorised by Rihanna were available in stores operated by companies in the defendants' group.³⁷

³⁰ Ibid.

³¹ C Wadlow, *The Law of Passing-Off: Unfair Competition by Misrepresentation*, 4th ed., (Sweet and Maxwell, 2011), para 3-131. Cited in *Starbucks (HK)*, para 59.

³² *Starbucks (HK)*, para 61.

³³ See, S Fletcher and J Mitchell, 'Court of Appeal Found no Love for Topshop Tank: The Image Right that Dare not Speak Its Name,' (2015) 37 EIPR 394, 397; Tan (n 7) 202 (noting that, 'The passing off action does not recognise a proprietary interest per se in a name, likeness or other indicia of identity, but it protects goodwill ... by preventing a trader from gaining an unfair competitive advantage through associating itself or its products with a well-known personality.').

³⁴ [2002] EWHC 367 at para 39.

³⁵ Ibid para 52.

³⁶ [2015] EWCA Civ. 3 at para 11.

³⁷ Ibid para 7.

However, in *Lyngstad v. Anabas*, (hereinafter, *ABBA* case) the famous music group, ABBA, attempted to prevent the defendants from exploiting their reputation for commercial gain through using their pictures in badges, pillow cases, and T-shirts that were being sold by the defendants.³⁸ In refusing the request for an interlocutory injunction, the court held that there was no real possibility of confusion and that the defendants were essentially ‘catering for a popular demand among teenagers for effigies of their idols.’³⁹ More importantly, even though the plaintiffs had a reputation within the country, they did not necessarily possess the goodwill required to succeed in a passing off action. Thus, as the court noted, the plaintiffs had no business with which the defendants’ goods could possibly be confused.⁴⁰ Crucially, the court stressed that ‘goodwill is of course an essentially localised concept and the court does not interfere to protect against exploitation here a foreign business which has established no goodwill here.’⁴¹

It has been suggested that the decision of the court in the *ABBA* case does not align with the transnational appeal of many contemporary celebrities.⁴² However, this suggestion overlooks the territorial nature of goodwill and it seems to conflate reputation with goodwill.⁴³ While the Supreme Court did not cite the *ABBA* case in its decision in *Starbucks (HK)*, both cases affirm the same long established principle i.e. claimants need to establish actual goodwill in England to succeed in a passing off action. It is contended here that both local and global celebrities therefore have to show goodwill to succeed in English courts. As the Supreme Court made clear in *Starbucks (HK)*, reputation is not a substitute for goodwill. Thus, celebrities that want to rely on passing off to restrain the unauthorised use of their images should take steps to start exploiting their images within the UK through the endorsements of local products or services. This would enable them to satisfy the requirement of showing goodwill in the country.

3. Why should Reputation not be enough for celebrities to Succeed in England?

As pointed out in part one above, as part of the justification for its decision in *Starbucks (HK)*, the Supreme Court highlighted the need to achieve a balance between the public interest in free competition and the protection of a trader against unfair competition.⁴⁴ According to the court,

More broadly, there is always a temptation to conclude that, whenever a defendant has copied the claimant’s mark or get-up, and therefore will have benefitted from the claimant’s inventiveness, expenditure or hard work, the claimant ought to have a cause of action against the defendant ... All developments, whether in the commercial, artistic, professional or scientific fields, are made on the back of other people’s ideas: copying may often be an essential step to progress. Hence, there has to be some balance

³⁸ [1977] FSR 62, 65.

³⁹ Ibid, 67-68.

⁴⁰ Ibid, 68.

⁴¹ Ibid, 66.

⁴² Tan (n 7) 214.

⁴³ See also, D Keeling et al, *Kerly’s Law of Trade Marks and Trade Names*, 16th ed., (Sweet and Maxwell, 2017) at para 20-058 (noting that, even in ‘cases where there is a reputation, where there is damage ... but the goodwill is situate elsewhere ... this type of case is not new, but the problem has become more acute with the increase in international travel, the growth of multinational businesses and the increasing influence of the Internet. In such circumstances, the territorial nature of goodwill under principles elucidated by the Supreme Court in *Starbucks* deprive the claimant of any relief under the law of passing off.’).

⁴⁴ *Starbucks (HK)*, para 61.

achieved between the public interest in not unduly hindering competition and encouraging development, on the one hand, and on the other, the public interest in encouraging, by rewarding through a monopoly, originality, effort and expenditure...⁴⁵

Thus, the court was cognizant of the need to create some breathing space to foster free competition and creativity in the society. Moreover, apart from the need to facilitate free competition, it is also important to note that the protection of image rights can have implications for the exercise of the right to freedom of expression. As Carty points out, ‘the celebrity image may be used as a vehicle for social comment or criticism’ and freedom of expression ‘is threatened when the publicity right is seen as allowing the celebrity to impose his “preferred meaning” not allowing different interpretations by others, though those interpretations may be used for powerful social criticism.’⁴⁶ In this regard, while not expressly referring to freedom of expression, the court further explained why allowing claimants to rely on mere reputation instead of goodwill is a bad idea. According to the court,

If it was enough for a claimant merely to establish reputation within the jurisdiction to maintain a passing off action, it appears to me that it would tip the balance too much in favour of protection. It would mean that, without having any business or any consumers for its product or service in this jurisdiction, a claimant could prevent another person using a mark, such as an ordinary English word, “now”, for a potentially indefinite period in relation to a similar product or service.⁴⁷

Ensuring that there is a balance between the public interest in free competition and the protection of a trader against unfair competition is therefore essential in order to guarantee that the tort of passing off does not evolve in a manner that negatively impacts the right to freedom of expression. Furthermore, it is true that the internet makes it easier for celebrities to spread their fame across the globe and this makes it tempting to desire the replacement of the requirement of goodwill with mere reputation. However, it is equally important to ensure that celebrities who have no ties to the country cannot rely on passing off to censor online social commentary or legitimate criticisms directed against them on the internet.

Conclusion

In sum, it is not really necessary to draw a distinction between commercial traders on the one hand and celebrities on the other hand with regard to the question of goodwill. Celebrities with a global reputation can and should equally be required to establish local goodwill when seeking to rely on the tort of passing off to restrain the unauthorised use of their images. Any attempt to do otherwise can disrupt the fine and delicate balance that the classic trinity of the tort of passing off seeks to maintain. As Carty helpfully reminds us:

⁴⁵ Ibid. See also Carty (n 14) 117 (noting that, ‘Competitive effort is encouraged by the strict classic trinity. This is because it provides the fence posts to avoid liability in the commercial game. The certainty thereby provided is a fundamental factor in planning and pursuing commercial and competitive activity, especially aggressive activity. And healthy competition -- and competition that best serves consumers -- may well also be aggressive competition.’).

⁴⁶ H Carty, ‘Advertising, Publicity Rights and English Law,’ [2004] IPQ 209, 252.

⁴⁷ *Starbucks (HK)*, para 62.

The strict classic trinity is a clever mechanism that combines the claimant's interests, the consumers' interests and the public interest ... And it means that not all appropriations, imitations, referencing of the market leader, attention-grabbing on the back of the claimant's success or riding on the brand leader's coat-tails will give rise to liability. Correctly applied, this tort does not seek to protect the psychological "pull" or commercial magnetism of a name – though that is what big brands seek ... The tort is seen as having a limited constructive part to play in the process of regulating competitive practices.⁴⁸

It should be noted that the requirement of goodwill is only one out of the three elements that make up the classic trinity of the tort of passing off. Thus, even if a claimant can establish goodwill, it is still necessary to establish misrepresentation and damage to goodwill in order to succeed. Nevertheless, the requirement of goodwill is an integral element of the classic trinity and replacing goodwill with reputation will not only upset the balance between the public interest in free competition and the protection of the trader/celebrity against passing off but it can also potentially have a negative impact on the exercise of the right to freedom of expression.

⁴⁸ Carty (n 14) 121.